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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/595,332

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Thomas Dennert

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EXAMINER

SHEN, QUN

ART UNIT

PAPER NUMBER

4153

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/595,332	Applicant(s) DENNERT ET AL.	
	Examiner QUN SHEN	Art Unit 4153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-15 and 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 April 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/6/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 1, drawn to a method of controlling a multi-device configuration related to changes in features in a telecommunication network, classified in class 455, subclass 418-420.
- II. Claims 2-15, 17-20, drawn to methods of optimizing network resource uses when switching from one or more parallel calls, classified in class 455, subclass 450, 509.
- III. Claim 16, drawn to a system for optimizing control of call routing/forwarding in a multiple-device configuration of a telecommunication system classified in class 455, subclass 445.

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as method of controlling system configuration with multiple end devices related to changes in features in a telecommunication network that is different and distinct from subcombination II, which provides methods of optimizing network resources uses when switching from one or more parallel calls in a telecommunication network. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Inventions I or II and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, various networks may be practiced by the methods as outlined in invention I or II as evidenced in applicant's own disclosure ("Background and problem definition").

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;

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- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

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If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Provisional election was made **without traverse** to prosecute the invention of **group II**, claims **2-15, 17-20**. Affirmation of this election must be made by applicant in replying to this Office action.

Claims 1 and 16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. **Claims 1-20** are currently pending and of which **Claims 2-15, 17-20** have been considered below.

Priority

Applicant's foreign priority claim for the benefits of German Patent Application No. 103 47617.2 on the basis of 35 U.S.C. 119 a-d & f, filed in the German Patent Office on October 9, 2003 is acknowledged.

Specification

The disclosure is objected to because of the following informalities:

Definition of B10/B20/B30 in line 1 of page 5 is not consistent with the rest of specification.

In various locations of the specification, “called end device” is used. For example, in paragraph [0017] 3rd line from bottom, “the **called** end devices...” would appear to mean end devices **being called**.

Numerous languages in specification are vague and unclear. For example, on the bottom line of paragraph [0024], “including ... “ is unclear. On line 4 of paragraph [0025], “**but also**” appears to mean **and also**.

Appropriate correction is required.

Drawings

The drawings are objected to because the drawings are illustrated in foreign language. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency.

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Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Regarding Claim 2, claim 2 is missing the linking term between the preamble and the body of the claim. In claim 2 and other subsequent claims, "called" is used in various locations. It appears the "**called**" should be "**being called**". For example, "... determine the system statues of the end devices **called**..." should be "... determine the system statues of the end devices **being called**..." in line 6 of claim 2.

Regarding claims 6, 8, dependent claims of claim 2, **the call forwarding** is lack of antecedent basis.

Regarding claims 2, 8, and 9, **and/or** is indefinite. Choose either **and** or **or** to clearly define the scope of the claims.

Regarding claims 4, 12, and 17, in claim language "... line is released again **up** to the origin of the connection", **up** should be removed as the specification provides no reference regarding the direction.

Applicant should go through claims and specifications

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-15, 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 4, 12, and 17, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claim 2, claim 2 is rejected as prolix as it contains long recitations or unimportant details that the scope of the claimed invention is rendered indefinite thereby. **See MPEP 2173.05(m) –Prolix.**

Claims 3-15, and 17-20, dependent upon claim 2, will also be rejected by default.

It is incumbent for the applicant to verify the metes and bounds of all claims and clarify them as needed.

For the purpose of prior art consideration, examiner will interpret the claims as reasonably as warranted. For example, examiner will construe the claimed invention as a method for optimizing network resources during the switching and process of one or more parallel calls to one or more end devices. The claimed invention comprises steps of 1) determining the system status of the end devices (or the identification chip connected to) being called, or the system status of the associated profile database; and 2) delivering a call based on said system status indicative of successful call attempts.

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The dependent claims to independent claims further comprise variations and limitations around the theme of invention recited in independent claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2-15 and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 0101707 A1 Immonen et al. (hereinafter Immonen).

Regarding claims 2-15 and 17-20, Immonen discloses **a method for optimizing network resources during the switching and process of one or more parallel calls to one or more end devices, comprising steps of 1) determining the system status of the end devices (or the identification chip connected to) being called, or the system status of the associated profile database (see page 2, line 33 - page 3, line – 6); and 2) delivering a call based on said system status indicative of successful call attempts (see page 3, lines 7-9).**

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to QUN SHEN whose telephone number is (571)270-7927. The examiner can normally be reached on Monday through Thursday, 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vu Le can be reached on 571-272-7332. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/QUN SHEN/
Examiner, Art Unit 4153

/Vu Le/
Supervisory Patent Examiner, Art Unit 4153